

## REMARKS

### 1. Summary of the Office Action

Claims 37-52 stand 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

### 2. Response to § 112 Rejections

Based upon the new independent claims 37, 44 and 48, Applicant respectfully disagrees with the Examiner's assertion.

A patent need not teach, **and preferably omits**, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). (Emphasis added). The fact that experimentation may be complex does not necessarily make it undue, **if the art typically engages in such experimentation**. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985).

The Office Action submits that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Further, the Office Action submits that Doberstein et. al. ( US 2003/0068649 A1) supports the numerous difficulties involved in relating gene sequences to other factors even using modern bioinformatics tools. As noted above, **the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation**. It is submitted that the art does in fact engage in such experimentation. This fact is conceded in the Office Action where it is stated that

lengthy research projects are associated with genetic sequences. Further, the Office Action cites Doberstein et. al. that provides examples of various prior art techniques that use experimentation. Any one of these (or other known techniques) may be used, by a person of skill in the art, in conjunction with the present invention, as claimed in claims 37-52.

In view of the above, Applicant respectfully submits that claims 37-52 satisfy the requirements under 35 U.S.C. § 112, first paragraph. Withdrawal of this rejection is respectfully requested.

3. **Conclusion**

Having tendered the above remarks, Applicant respectfully submits that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Garth Vivier at (408) 947-8200 ext. 245.

Respectfully submitted,

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